



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/385,394	08/30/1999	JOHN S. YATES JR.	114596/03-4000.	9093

38492 7590 02/14/2005

WILLKIE FARR & GALLAGHER LLP
INTELLECTUAL PROPERTY LEGAL ASSISTANTS
787 SEVENTH AVE
NEW YORK, NY 10019-6099

EXAMINER

ELLIS, RICHARD L

ART UNIT PAPER NUMBER

2183

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/385,394

Applicant(s)

YATES ET AL.

Examiner

Richard Ellis

Art Unit

2183

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: 1-21,37-50,113-116 and 119-133.

Claim(s) objected to: 34-36,60,67 and 86.

Claim(s) rejected: 22-33,51-59,63-66,68-85 and 87-112.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See attached response to request to withdraw finality.


RICHARD L. ELLIS
PRIMARY EXAMINER

Continuation of 2. NOTE: The proposed language changes to claim 63 would require further consideration and/or search.

Attachment to advisory action.

1. As an initial matter, applicant appears to be confused as to the nature of when and why an application is to be made final. Applicant is reminded of the clear wording of the MPEP:

706.07(a) [R-1] Final Rejection, When Proper on Second Action

Due to the change in practice as affecting final rejections, older decisions on questions of prematurity of final rejection or admission of subsequent amendments do not necessarily reflect present practice.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

It is noteworthy to point out that the clear wording is: "second or any subsequent actions on the merits shall be final". The meaning of "shall" is:

"Shall ... b -- used in laws, regulations, or directives to express what is mandatory"

Accordingly, the clear language is that all second or subsequent actions on the merits must (i.e., are required to) be final. There is but one sole exception to the mandatory nature of second or subsequent actions being final within the clear directive of the MPEP, and as that one sole exception does not exist in this application, the last office action was required to be made final.

2. In applicant's request for withdrawal of finality of office action, received January 25, 2005, applicant avers the following:

3. "Claim 104 has Not Been Examined"

Applicant is in error in this statement. Claim 104 was examined, and was rejected, in paper number 38, mailed February 11, 2004, at paragraph 42. Claim 104 is rejected with Goetz et al. in the exact same manner as claim 4 (as claim 4 existed on February 11, 2004, due to the fact that claim 104 is simply a restatement of claim 4 (as claim 4 existed on February 11, 2004)). A fact that applicant should have been immediately aware of because applicant himself wrote the claims. Accordingly, claim 104 was rejected.

Applicant is additionally confused because paragraph 14.7 of the Office Action of October 2004 contains a copy of the response from paragraph 14.1 regarding claim 22. This

was a typographical mistake in the office action of October 2004. The correct response was:

Goetz et al. taught using "the instructions ... following first and second data storage conventions" at col. 15 lines 45-49.

4. "No "Clear Issue" Is Developed for Claim 22"

Applicant is additionally in error in this statement. If applicant were to have referred to the rejection of claim 22 at paragraph 52 of the February 2004 office action, he would have recognized that the rejection of claim 22 was based upon a combination of references, specifically Goetz et al. in view of Brender et al. and Murphy et al. He would also have recognized from the rejection that although Goetz et al. contained the claimed indicators (52.4) that it was Brender et al. and Murphy et al. which provided the teaching of "data storage convention" portion of this particular claim. Therefore, by arguing that Goetz et al. alone did not teach the complete claimed aspect, applicant was indeed arguing the references individually, and as such, the response given was exactly that which was necessary to rebut applicant's argument.

5. "The Office Action of October 2004 Raises a New Ground of Rejection of Claim 87, an Unamended Claim"

Applicant is additionally in error in this statement. The grounds of rejection of claim 87 in the February 2004 office action was the combination of Goetz et al., Brender et al., and Murphy et al. (paragraphs 46 & 100). The grounds of rejection of claim 87 in the October 2004 office action was the combination of Goetz et al., Brender et al., and Murphy et al. (paragraph 11). The grounds of rejection are identical between the two office actions. Therefore, no new ground of rejection was raised in respect to claim 87.

6. "IV. ... A number of references submitted on the Form 1449 filed July 12, 2004, and returned with the Action of October 2004 are crossed off without consideration. Contrary to the statement in the Office Action, legible copies of all required references were made available in parent applications that were identified in the Information Disclosure Statement."

Applicant then continues on to detail where each submission can be found in parent application 09/322,443.

As to the references which were submitted in parent application 09/322,443, it appears that there was a crossing in the mail situation, in that the referenced documents were submitted to the office approximately three weeks prior to the mailing date of the October office action. At the time of completion of the October office action, those references had not yet been placed of record into parent application 09/322,443, and as such, could not be located. However, in the ensuing time, those references have been placed of record into parent application 09/322,443, and as they were indeed filed prior to the mailing date of the October office action, those references copies which submitted in parent application 09/322,443 have been considered and an additional copy of applicant's 1449 form showing consideration of those references is attached hereto.

However, one reference, WO 99/08188 to Kelly, did not have a copy submitted in parent application 09/322,443, does not exist at this time as a copy in application 09/322,443, and as admitted by applicant on page 5 of the request, was only submitted as a copy in grandparent application 09/239,194. Applicant is reminded of the pertinent rules which authorize applicant to omit copies of references in IDS submissions:

37 CFR 1.98. Content of information disclosure statement.

(a) Any information disclosure statement filed under § 1.97 shall include:

(1) A list of all patents, publications, applications, or other information submitted for consideration by the Office;

(2) A legible copy of:

(i) Each U.S. patent application publication and U.S. and foreign patent;

(ii) Each publication or that portion which caused it to be listed;

(iii) For each cited pending U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and

(iv) All other information or that portion which caused it to be listed; and

(3)

(i) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or

other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein.

(ii) A copy of the translation if a written English-language translation of a non-English language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c).

(b)

(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.

(2) Each U.S. patent application publication listed in an information disclosure statement shall be identified by applicant, patent application publication number, and publication date.

(3) Each U.S. application listed in an information disclosure statement must be identified by the inventor, application number, and filing date.

(4) Each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application.

(5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

(c) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.

(d) A copy of any patent, publication, pending U.S. application or other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless:

(1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and

(2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.

The pertinent part of the applicable rules is section (d)(2). The IDS filed in the parent application must comply with paragraphs (a) through (c). Paragraphs (a) through (c) require that legible copies be provided. In the case of the "WO 99/08188 Kelly" reference, a legible copy was not provided in parent case 09/322,443, however the IDS which cited Kelly relied upon section (d) of § 1.98 and as such, a copy of Kelly was not required in parent case 09/322,443. However, by complying with section (d) of § 1.98, the IDS in 09/322,443

FAILED TO COMPLY with sections (a) through (c) as regards the Kelly reference.

Accordingly, the IDS in this application can not omit a legible copy of Kelly and rely on the citation of Kelly in 09/322,443 because that citation in 09/322,443 FAILS TO COMPLY with sections (a) through (c), which is a requirement of § 1.98, (d)(2). Accordingly, the Kelly reference remains **unconsidered**.

7. Finally, applicant's two information disclosure statements submitted after final rejection are also not considered. Both statements fail to contain a statement of timely submission which is a requirement for consideration of an information disclosure statement after final rejection. (See MPEP 609(B)(5))

Therefore, for all of the above reasons, the final rejection **stands**.